

OCT 04 2001



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Eitan, Pearl, Latzer & Cohen-Zedek  
One Crystal Park, Suite 210  
2011 Crystal Drive  
Arlington, VA 22202-3709

In re Application of LINIAL et al  
U.S. Application No.: 09/601,278  
Int. Application No.: PCT/IL99/00057  
Int. Filing Date: 29 January 1999  
Priority Date: 29 January 1998  
Attorney Docket No.: P-1476-US  
For: AN AUTOMATIC METHOD OF  
CLASSIFYING MOLECULES

## DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This is in response to applicants' "A Renewed Petition Under 37 C.F.R. 1.47(a)" filed 13 August 2001, requesting that the present application be accepted for United States national stage processing without the signature of one of the four joint inventors.

**BACKGROUND**

On 29 January 1999, applicants filed international application PCT/IL99/00057, which claimed priority of an earlier United States application filed 29 January 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 05 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 31 July 2000 (29 July 2000 was a Saturday).

On 31 July 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, authorization to charge the requisite basic national fee required by 35 U.S.C. 371(c)(1) and an unsigned declaration.

On 22 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

Application No.: 09/601,278

-2-

On 22 February 2001, applicants filed a petition under 37 CFR 1.47(a) along with a declaration signed by three of the four joint inventors and not signed by inventor Golan Yona.

On 12 June 2001, the PCT Legal Office of the USPTO mailed a decision dismissing the 22 February 2001 petition for failure to demonstrate that a bona fide attempt was made to present a copy of the complete application papers to Yona for signature and for failure to show that Yona refuses to join in the application.

On 13 August 2001, applicants filed the present renewed petition. The renewed petition states that it is accompanied by an affidavit from Renee Ben-Israel.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicants have previously satisfied items (1), (3), and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Application No.: 09/601,278

-3-

In the present case, applicants have not demonstrated that a bona fide attempt was made to present a copy of the complete application papers (including specification, claims, drawings, and oath/declaration) to the nonsigning inventor Yona for signature. The affidavit of Renee Ben-Israel states that a copy of the declaration and power of attorney was sent via facsimile to Yona on 03 October 2000 (see paragraph 7 of Ben-Israel's affidavit). However, the affidavit does not establish that any attempt was made to present the specification, claims, and drawings to Yona. Furthermore, Ben-Israel's affidavit specifically states, "I did not forward him a copy of the Subject Application." (See paragraph 8 of Ben-Israel's affidavit). Ben-Israel's affidavit states that statements made by Yona in an electronic mail message dated 02 November 2000 show that Yona reviewed the application (see paragraph 8 and Exhibit 4 of Ben-Israel's affidavit). Ben-Israel's affidavit further states that a letter dated 27 December 2000 indicates that Yona has "obtained a copy of the PCT" (see paragraph 9 and Exhibit 5 of Ben-Israel's affidavit). However, MPEP 409.03(d) requires that a bona fide attempt be made to present a copy of the application papers to the non-signing inventor for signature. No evidence has been provided regarding any such attempt by applicants. Therefore, it is unreasonable to conclude at the present time that Yona refuses to join in the application.

### CONCLUSION

Because applicants have failed to satisfy item (2) above, the renewed petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Bryan Tung  
PCT Legal Examiner  
PCT Legal Office

Telephone: 703-308-6614  
Facsimile: 703-308-6459

4.APR.2002 16:33

EITAN PEARL LATZER+COHEN-ZEDEK

.on617

.nu10

# EXHIBIT 1

4. APR. 2002

16:34

EITAN PEARL LATZER+COHEN-ZEDEK

JUN 12 2001



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
Washington, D.C. 20231  
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Eitan, Pearl, Latzer & Cohen-Zedek  
One Crystal Park, Suite 210  
2011 Crystal Drive  
Arlington, VA 22202-3709

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17 -06- 2001

ETAN, PEARL, LATZER & COHEN-ZEDEK

In re Application of LINIAL et al  
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CLASSIFYING MOLECULES

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This is in response to applicants' "Petition Under 37 C.F.R. 1.47(a)" filed 22 February 2001, requesting that the present application be accepted for United States national stage processing without the signature of one of the four joint inventors.

### BACKGROUND

On 29 January 1999, applicants filed international application PCT/IL99/00057, which claimed priority of an earlier United States application filed 29 January 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 05 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 31 July 2000 (29 July 2000 was a Saturday).

On 31 July 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, authorization to charge the requisite basic national fee required by 35 U.S.C. 371(c)(1) and an unsigned declaration.

On 22 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

Application No.: 09/601,278

-2-

On 22 February 2001, applicants filed the present petition along with the appropriate extension of time fee. The petition states that it is accompanied by, *inter alia*: 1) a declaration signed by three of the four joint inventors and not signed by inventor Golan Yona; 2) an affidavit of Renee Ben-Israel, and 3) an authorization to charge the requisite petition fee.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by three of the four joint inventors on their own behalf and on behalf of the nonsigning inventor Yona.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have not demonstrated that a bona fide attempt was made to present a copy of the complete application papers (including specification, claims, drawings, and oath/declaration) to the nonsigning inventor Yona for signature. Although the affidavit of Renee Ben-Israel states that a copy of the declaration and power of attorney was sent via facsimile to Yona around 03 October 2000 (see paragraph 8 of Ben-Israel's affidavit), the affidavit

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-3-

does not establish that the specification, claims, and drawings were ever presented to Yona. Ben-Israel's affidavit states, "As is evident from the e-mail dated November 2, 2000, Golan Yona reviewed the PCT Application" (see paragraph 9 of Ben-Israel's affidavit). However, applicants have not provided an affidavit of the person having firsthand knowledge of the PCT application (including specification, claims, and drawings) being presented to Yona.

Furthermore, applicants have not provided adequate proof of Yona's purported refusal to sign the application papers. Ben-Israel's affidavit states that Ben-Israel made numerous attempts to obtain Yona's signature on the declaration (see paragraph 10 of Ben-Israel's affidavit), yet fails to provide any details regarding the alleged attempts. Thus, it would be inappropriate at the present time to conclude that Yona refuses to join in the application.

With regard to item (3) above, applicants have provided the requisite petition fee.


With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

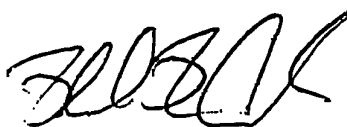
### CONCLUSION

Because applicants have failed to satisfy item (2) above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

  
Bryan Tung  
PCT Legal Examiner  
PCT Legal Office

  
Richard Cole  
PCT Legal Examiner  
PCT Legal Office

Telephone: 703-308-6614  
Facsimile: 703-308-6459

## EXHIBIT 2



Attorney Docket No.: P-1476-US

**DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below under my name.

I believe that I am the original, first and sole inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled

**AN AUTOMATIC METHOD OF CLASSIFYING MOLECULES**  
the Specification of which

☐ is attached hereto  
☒ was filed on January 29, 1999  
as Application Serial No. PCT/IL99/00057  
and was amended on \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified Specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, 1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any provisional application filed in the United States in accordance with 35 U.S.C. §1.119(e), or any application for patent that has been converted to a Provisional Application within one (1) year of its filing date, or any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

**PRIOR FILED APPLICATION(S)**

<u>APPLICATION NUMBER</u>	<u>COUNTRY</u>	<u>(DAY/MONTH/YEAR FILED)</u>	<u>PRIORITY CLAIMED</u>
60/072,977	US	29-Jan-98	YES
PCT/IL99/00057	PCT	29-Jan-99	YES

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application listed below, and, insofar as the subject matter of each of the claims of this application is not disclosed in any prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a), which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

4. APR. 2002 16:35

EITAN PEARL LATZER+COHEN-ZEDEX  
LAW OFFICE

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Attorney Docket No.: P-1476-US

APPLICATION  
NO.

PCT/IL99/00057

FILING DATE  
(DAY/MONTH/YEAR)

29-Jan-99

STATUS - PATENTED,  
PENDING, ABANDONED

I hereby appoint as my attorney(s) and agent(s) Heidi M. Brun (Agent, Registration No. 35,104), or Jerome R. Smith, Jr. (Attorney, Registration No. 35,684), or Daniel J. Swinsky (Agent, Registration No. 45, 148) or Mark S. Cohen (Attorney, Registration No. 42, 425) or Rachel L. Abhoudi (Agent, Registration No. 44,490) or Suzanne Erez (Agent, Registration No. P-46,688) said attorney(s) and agent(s) with full power of substitution and revocation to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Please address all correspondence regarding this application to:

EITAN, PEARL, LATZER, & COHEN-ZEDEX  
ONE CRYSTAL PARK, SUITE 210  
2011 CRYSTAL DRIVE  
ARLINGTON, VA 22202-3709

Direct all telephone calls to (703) 486-0600 and all facsimiles at (703) 486-0800.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

FULL NAME OF INVENTOR: LINTAL, Michal

FULL RESIDENCE ADDRESS: 18 Neve Shaanan Street, Apt. 17,  
Jerusalem 93707, Israel

COUNTRY OF CITIZENSHIP: Israel

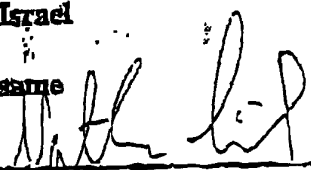
FULL POST OFFICE ADDRESS: same

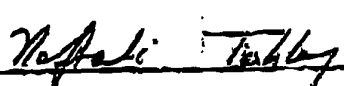
SIGNATURE OF INVENTOR

DATE

Sept 17, 2000

Attorney Docket No.: P-1476-US

FULL NAME OF INVENTOR: LINIAL, Nathan  
FULL RESIDENCE ADDRESS: 18 Neve Shaanan Street, Apt. 17  
Jerusalem 93707, Israel  
COUNTRY OF CITIZENSHIP: Israel  
FULL POST OFFICE ADDRESS: same  
SIGNATURE OF INVENTOR   
DATE Sept. 17, 2000

FULL NAME OF INVENTOR: TISHBY, Naftali  
FULL RESIDENCE ADDRESS: 6 Hadishan Street, Jerusalem 96956, Israel  
COUNTRY OF CITIZENSHIP: Israel  
FULL POST OFFICE ADDRESS: same  
SIGNATURE OF INVENTOR   
DATE Sept. 17, 2000

FULL NAME OF INVENTOR: YONA, Golan  
FULL RESIDENCE ADDRESS: 3 Haraz Street, Rehovot 76310, Israel  
COUNTRY OF CITIZENSHIP: Israel  
FULL POST OFFICE ADDRESS: same  
SIGNATURE OF INVENTOR \_\_\_\_\_  
DATE \_\_\_\_\_

4.APR.2002 16:36

EITAN PEARL LATZER+COHEN-ZEDEK

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## EXHIBIT 3

**Subject:** [Fwd: Patent status report and docs for signature re Protomap patent]  
**Date:** Tue, 17 Oct 2000 13:30:16 +0200  
**From:** Renee Ben-Israel <renee@yisum.co.il>  
**Organization:** Yisum  
**To:** Golan Yona <golan@gimmel.stanford.edu>

Dear Golan,

I tried calling you yesterday night but was told that you weren't in.  
I'll try again later today.  
Any news with the docs? If you have any question, please let me know.  
Thank you.  
Renee

--  
Renee Ben-Israel  
Intellectual Property Manager  
Yisum Research Development Co.  
of the Hebrew University of Jerusalem  
POB 4279, Jerusalem 91042, IL  
Tel: 972-2-563-4880 (ext 204) Fax: 972-2-566-0331

---

**Subject:** Patent status report and docs for signature re Protomap patent  
**Date:** Tue, 03 Oct 2000 12:20:05 +0200  
**From:** Renee Ben-Israel <renee@yisum.co.il>  
**Organization:** Yisum  
**To:** Golan Yona <golan@gimmel.stanford.edu>  
**CC:** "Linial Michal, Dr." <michall@leonardo.lis.huji.ac.il>,  
"Linial Natan, Prof." <nati@cs.huji.ac.il>,  
"Tishby Naftali, Prof." <tishby@cs.huji.ac.il>

Dear Golan,

Please accept my apologies for the tardiness of my letter, in fact I understood that you were supposed to be here before Rosh Hashana and therefore didn't send you any papers by mail. Now, I understand that you are scheduled to arrive this week but in order to expedite matters, I'll fax you the documents for your signature as well as the other requested papers.

The docs are the ones related to the US application, namely: Declaration and Power of Attorney and Assignment, please sign with blue ink beside your name, thank you. For your information and this may also be a good opportunity to update Michal, Nati and Taly too in a more detailed way, the patent status of this case is as follows:

Following the first Provisional application filed in January 1998 we have subsequently (January 1999) filed a PCT application designating "all countries". The PCT application was published in August 5, 1999, publication no. WO 99/39174 (a copy of the front page is attached in the fax). The countries designation, in fact, gives you, within 18 months from its filing, the possibility of choice among the "all countries" list, in which countries you really intend to have the patent valid. After long deliberations, we have finally settled for the USA, Europe and Japan considering that these are the most important markets for the technology. The expected actions now are Examination in each of the countries, separately, until the final allowance and granting of the same patents. In the US it may take around a year before we receive a first Office Action, in Europe a bit longer and in Japan we have 7 years before Examination unless we request an Expedite Process.

Apart from that I am attaching to the fax the Hamtsaat Sherut form provided by the inventors prior to the filing and the Horaot Hanhala 15-001 as a reference, I think that these are the papers you requested.

Should you have any question, please don't hesitate contacting me.

As for the other issues, I may send it to you in a separate letter, or let's discuss it when you're here.

Best regards and shana tova,

Renee

--  
Renee Ben-Israel  
Intellectual Property Manager  
Yisum Research Development Co.  
of the Hebrew University of Jerusalem  
POB 4279, Jerusalem 91042, IL  
Tel: 972-2-563-4880(ext 204) Fax: 972-2-566-0331

# EXHIBIT 4

**Subject: Re:****Date:** Tue, 14 Nov 2000 10:25:35 -0800 (PST)**From:** G lani Yona <golan@gimmel.stanford.edu>**To:** Renee Ben-Israel <renee@yisum.co.il>

Dear Noemi

Please send documents to that address.  
Golan

-----  
Golan Yona

Department of Structural Biology  
Stanford University  
Fairchild Science Building D-109  
Stanford, California 94305-5126  
U.S.A

<http://csb.stanford.edu/golan/>Phone: (650) 725-0754 Fax: (650) 723-8464  
-----

On Tue, 14 Nov 2000, Renee Ben-Israel wrote:

> Dear Golan,  
> Please let us have your mailing address, in order to send you a copy of a  
letter  
> concerning the prosecution of one of the patent applications.  
> thank you  
> Noemi Lerner  
> Intellectual Property Yisum  
>  
> Golan Yona wrote:  
>  
> > Dear Renee  
> >  
> > We will call you either monday morning, or monday  
> > afternoon, your time. There is no need for a conference  
> > call yet. We would like just to clarify few issues.  
> > When are you available at your office?  
> >  
> > Golan  
> >  
> > On Thu, 2 Nov 2000, Renee Ben-Israel wrote:  
> >  
> > > Dear Golan,  
> > >  
> > > I am sorry, I don't think this discussion is leading us anywhere. You  
> > > certainly have the right to see the facts as you see them and all I can do  
is  
> > > to try and explain to you Yisum's procedures vis-a-vis inventors'  
updating.  
> > > When we decide to file an application we request a "tofes Hamtsaat Sherut"  
> > > from the inventors where they disclose, among other details, their  
invention,  
> > > funding they may have received, the list of inventors and their  
proportional  
> > > rights, personal data as addresses, citizenship, etc. Since the request is  
> > > usually done by one of the inventors and when all of them belong to the  
same  
> > > institution we typically correspond with one inventor only. When the  
invention  
> > > is developed by more than one institution we correspond with the other  
> > > institution, as well, we have an Inter Institutional agreement signed



between

> > > the parties, etc. Having all parties agreeable, we proceed with the filing.  
> > > The usual procedure is to send it to a patent attorney to have it drafted  
in  
> > > the best possible way in order to provide us with the best and broadest  
> > > possible patent protection.  
> > > In the case of this file, since we started with a Provisional filing based  
on  
> > > a paper written by 4 persons of the HUJI this wasn't done, we sent the  
paper  
> > > to Eitan, Pearl, etc. and after receiving their ok, it was filed "as is" in  
> > > the US PTO. At this stage you were my "contact person" but some time  
> > > afterwards you left and I sent the correspondence to Nati.  
> > > A year later, when we reached the end of the Provisional filing we had to  
> > > decide on the next steps and since this was considered a good project and  
we  
> > > had received funding from the Horowitz fund (I believe you are acquainted  
with  
> > > this fact since I can see your signature in the Horowitz fund document  
letter)  
> > > we decided to file it in the PCT. At this point, we requested Eitan, Pearl,  
> > > etc. office to draft the patent as usual (in the best and broadest possible  
> > > way) and this is exactly what was done and what any sensible patent owner  
> > > would have done. I have a Power of Attorney form signed by Yisum's CEO  
and  
> > > all the inventors (including yourself) in my file. A copy of the PCT  
> > > publication was sent to Nati in September 1999.  
> > > The next step was the National Phase (July 2000), here we had to decide in  
> > > which countries we wanted to keep the application. There were long  
> > > deliberations since we typically won't incur such expenses without a  
> > > licensee's support, but we finally decided to file it in the US, Europe and  
> > > Japan. The decision is Yisum's decision only since this is Yisum's  
> > > proprietary know-how and the costs are borne by Yisum. We appreciate  
> > > receiving inventors' feedback but the final decision is Yisum's one.  
Should  
> > > we decide to drop the entire portfolio it's our prerogative to do so. What  
we  
> > > usually do in these cases is to present the inventors the option of keeping  
it  
> > > at their own expense. Since this wasn't the case, you weren't offered this  
> > > option.  
> > > As I told you previously, you are certainly entitled to see the facts from  
> > > your point of view, but from Yisum's standpoint this was a regular  
procedure.  
> > > We correspond with one inventor only assuming that the group works  
together.  
> > > Should you want to receive information from our office, you are welcome to  
> > > request it.  
> > > As for the US and European versions: I haven't yet received them from  
Eitan,  
> > > Pearl office but they are both based in the PCT version. I have the  
Japanese  
> > > translation if you are interested in it.  
> > >  
> > > I hope to have clarified the matter. Should you have any questions, please  
> > > don't hesitate contacting me. I would also like to suggest a conference  
call  
> > > between you, Prof. Levitt, Rachel Bentov, Nati, Tali and me (Michal is away  
at  
> > > the moment) in order to overcome the problems. Please let me know what is a  
> > > suitable time for you. Thank you.  
> > >  
> > > Sincerely  
> > >  
> > > Renee  
> > >  
> > >



4.APR.2002 16:38

EITAN PEARL LATZER+COHEN-ZEDEK

.on617

.nu25

# EXHIBIT 5

MEIR A. FUCHS<sup>\*,</sup> Adv.  
Corporate Division  
MEIR DAHAN, Adv.  
Intellectual Property Division

MEIR DAHAN, Adv.  
ARYEH LITT, Adv.  
MEIR A. FUCHS<sup>\*,</sup> Adv.  
DR. MARK M. FRIEDMAN<sup>\*,</sup> Adv., Patent Att.  
MOSHE KRISTAL, Adv.  
YEHUDA RAMM<sup>\*,</sup> Adv.

\* also admitted in Texas  
\*\* also admitted in New York

ד"ר מרק פרידמן ושות', עורכי דין ועורכי פטנטים

DR. MARK FRIEDMAN & CO.  
ADVOCATES & PATENT ATTORNEYS

בית סמואלוב, רח' האומנים 7, קומה 4, תל אביב 67897  
Samueloff Building, 7 Haomanim Street, 4th Floor  
Tel Aviv 67897, Israel

טלפון: 972 3 5625553  
פקסימיליה: 972 3 5611333  
EMAIL: patents@friedpat.com  
WEBSITE: www.israel-patent.com

מאיר פוקסיי, ע"ד  
תחום חברות  
מאיר דהאן, ע"ד  
תחום קניין רוחני

מאיר דהאן, ע"ד  
אריה לית, ע"ד

מאיר פוקסיי, ע"ד  
ד"ר מרק פרידמן, ע"ד וע"ד  
משה קריסטל, ע"ד  
יהודה רממי, ע"ד

\* מוסמך גם בטקסס  
\*\* מוסמך גם בניו יורק

December 27, 2000  
**WITHOUT PREJUDICE**

✓ MR. MOTI PERLMOTER, CEO  
YISSUM RESEARCH DEVELOPMENT COMPANY OF  
THE HEBREW UNIVERSITY OF JERUSALEM  
POB 4279, JERUSALEM 91042

BY MAIL  
AND ALSO BY FAX: 02-566 0331

Re: Dr. Yona Golan - ProtoMap

Dear Sirs,

On behalf of our client, Dr. Golan Yona, I am writing to you again and I hereby repeat my letter dated October 26, 2000, to which regrettably you didn't reply. It seems to me outrageous that I have not yet received any comment from you on the issues mentioned in my letter. I repeat my client allegations regarding the matter, as follows:

1. As a footnote, it should be noted that neither Cornell University nor Stanford University have or claim any rights in the Invention (as defined below) or in the ProtoMap Internet site. In addition, neither of these universities make any commercial use of the Invention and of the above Internet site and they also have no intention of doing so. Therefore it is pointless to address these universities with this issue. I strongly suggest you to address me as Dr. Golan's attorney with any matter concerning this issue and I am still looking to have your reply to my letters.

2. Rights in the Invention:

(a) Our client is the inventor of an Automatic Method of Classifying Molecules (The Invention). Our client owns 80% (eighty percents) of the Invention. The remaining 20% (twenty percents) of the Invention are owned together by Prof. Nathan Linial, Dr. Michal Linial and Prof. Naftali Tishbi.

December 27, 2000

(b) Our client is the legal owner of 80% (eighty percents) in every patent or patent application that will be filed for the Invention or that was already filed for the Invention. For legal and factual arguments which will be brought in detail if necessary, the Hebrew University Regulations which states that for the purpose of ownership in inventions a postgraduates and Ph.D. students will be considered as an University employee, are not relevant in our client's case and do not bind him.

3. Rights in the Computer Programs

(a) Dr. Yona Golan also owns the substantial copyrights in the computer programs which are used for the implementation of the Invention, the use in the outcome of the subject method of the Invention and its representation in the Internet sites (hereinafter "The Computer Programs"). Such copyrights vests in Dr. Golan, *inter alia*, since he is the author and the creator of the Computer Programs.

(b) In fact, your use of the Computer Programs in your Internet sites constitute an infringement of our client's copyrights in the Computer Programs.

4. Signing documents in connection with the patent applications

(a) Our client has never received from you a formal copy of any patent application. Our client will be prepared to sign any documents which are required for the filing and/or the handling of patent applications in connection with the Invention, including a patent application that will be filed or has already been filed in the US, subject to the condition that these documents will rightly and truly reflect the factual, intentional and legal reality.

(b) Although you have never sent to my client any formal copy of the patent application, he obtained a copy of the PCT from the Internet. It should be noted that on primary examination of the PCT it seems that the claims are exceeding the Invention.

5. You are therefore required to proceed as follows:

(a) To register our client as the owner of 80% (eighty percents) of every patent application that will be filed or has already been filed in connection with the Invention.

(b) To notify our client on every agreement and/or legal engagement and/or negotiation which you are handling in connection with the use and/or the commercialization and/or the exploitation of the Invention.

(c) In this stage our client agrees that you will continue to use, for academic use only, the Computer Programs in your Internet sites in which the ProtoMap technology is presented.

(d) To bear our client's expenses to enable him to devote the required time for studying the documents and the patent applications.

December 27, 2000

6. Bearing in mind the complexity of this issue, I hope that you will offer our client a serious and reasonable settlement offer to end the dispute by way of a settlement.

Sincerely yours,

Meir Zeman, Adv.  
Dr. Mark Friedman & Co.

cc: Dr. Golan Yona

/mwl/letters/v/170110

# EXHIBIT 6

08/07/2001. 12:11 PM



YEHUDA RAVEH &amp; CO. - LAW OFFICES

יהודה רבה ושות' - משפד עורכי

2

26 Ushkida Street P.O.Box 7722, Jerusalem 91077  
 35 Shani Hamelach Blvd P.O.Box 33804 Tel Aviv 64927

רח' אושיסקין 26 ת.ד. 7722, ירושלים 91077  
 שדרות שאול המלך 35, ת.ד. 33804, חל-אביב 64927

in their field) in developing the Protomap Technology which is the basis for the Invention. Thereafter, a patent application in respect of the Invention was filed in the name of my client.

3. All research leading to the Invention, as well as the scientific and academic developments underlying it, were carried out at the Hebrew University and funded thereby. The three head researchers and Dr. Yona were all, at the time, employees of the Hebrew University. The result of the above is that all inventions stemming from the research are owned by my client subject to University rules and regulations. Furthermore, all the researchers, including Dr. Yona, signed a written statement declaring the Invention a "Service Invention," the result of which is fully clear to you.
4. We of course reject your client's contention that he is the legal owner of 80%!! of any patent relating to the Invention or tht he has any rights at all in the Invention, though, the lead researchers agreed to grant your client 25% of any rights which are granted to the "inventor's", under the Hebrew University regulations.
5. My client was in touch with Dr. Yona however they failed to reach an amicable understanding despite their efforts and good intentions. In light of the above your client is hereby required to cease all and any commercial or other use of the Invention and the Computer Programs and to terminate operation of the web site both at Cornell University and at Stanford University, which are violating my client's rights.

Your early response to this letter would be appreciated.

Best regards,

Yehuda Glatt

Cc: Yissum

# EXHIBIT 7

**YEHUDA RAVEL & CO. - LAW OFFICES**

**יהודה רחל ושות' - משרד עורכי דין**

26 Ushkkin Street P.O.Box 7722, Jerusalem 91077  
Rabinstein House, 20 Lincoln St., Tel Aviv 67134

רח' אוסר קין 26 ת.ד. 7722, ירושלים 91077  
בית רובינשטיין, רח' לינקולן 20, תל אביב 67134

Yehuda Ravel  
Lisa Tross  
Haim Stern  
Sara Shalom  
Yuval Grayovsky  
Carmel Bar-On  
Yehuda Glatt  
Dana Savitch  
Uri Yamin  
Myriam Abitbol  
Jeremy Rosenblum  
Jonathan Finklestone  
Jonathan Leibler  
Binua Ben-Sadon  
Gabriel Rubenbach  
Liat Rakotch  
Chagai Ullman  
Michael Oster  
Rami Raboy  
Sharon Elidan  
Shelly Bakshi  
Arieh Holzer  
Daphna Fuchs  
Maitan Ben Shaul  
Nir Zanzari  
Sharon Florentin  
Paul Landes  
Yaron Sallat

**Jerusalem Office** משרד בירושלים  
Tel: 02-5635232 :טל  
Fax: 02-5617101 :פקס  
E-mail: lawfirm@yrahel.co.il

**Tel-Aviv Office** משרד בתל-אביב  
Tel: 03-5620303 :טל  
Fax: 03-5618338 :פקס  
E-mail: ravchtlv@yrahel.co.il

Of Counsel:  
Tamar Hershkov-Ravel  
Tamar Ben-David

יהודה רחל  
ליזה טרוס  
חיים שטרן  
סרה שלום  
יואל גרייבסקי  
כרמית בר-און  
יהודה גלד  
דניאל סאביץ'  
אורי ימין  
מרים אביטבול  
ירמי רוזנשטיין  
יונתן פינקלשטיין  
יונתן ליבלר  
בניה בן-סדון  
גבריאל רובנבך  
ליאת רקוטש  
חגי אולמן  
מיכאל אוסטר  
רמי רבוי  
שרון אלידן  
שלי בקשי  
אריה הולצר  
דפנה פוקס  
מיתן בן שאול  
ניר זנזרי  
שרון פלורנטיין  
פול לנדס  
ירון סלל

תמר הארשר-רחל  
תמר בן-דוד

Jerusalem, 19 February 2001

To: Mr. Meir Daban

By Fax: 03-5611333  
03-5625554

From: Yehuda Glatt

Re: Golan-Yissum-Reminder

Dear Mr. Daban,

I have not heard from you in respect of my previous fax of 16.2.01.

It is of utmost importance that your client signs the forms, which are required for registration of the patent in the U.S. As I explained in my letter, the last date for submission is 22.2.01 therefore your client's urgent response is required. Let me stress that your client's delay will cause my client substantial damage.

I am attaching, once again, my above mentioned letter:

Best regards,

Yehuda Glatt

CC: Renee Ben-Israel - Yissum

115286

# EXHIBIT 8

**Yissum Research Development Company  
of The Hebrew University of Jerusalem**

**Intellectual Property Department**

POB 4279, Jerusalem 91042

Tel: 972-2-563-4880 (ext 204 or 212) Fax: 972-2-566-0331

e-mail: renee@yissum.co.il or noemi@yissum.co.il

**FACSIMILE COVER SHEET**

DATE: 21 Feb 2001

FACSIMILE NUMBER: 03-562-5554

TO: Adv. Meir Dahan

COMPANY: Dr. Mark Friedman Ltd.

FROM: Renee Ben-Israel

No. of pages (including cover): 3

If you do not receive all the pages, please inform us promptly.

**Message:**

2nd. Reminder!  
Dear Mr. Dahan,  
Please note that the absolute  
deadline for filing the document  
is tomorrow Feb 22, 2001.

Sincerely

Renee Ben-Israel

# EXHIBIT 9



**Yissum Research Development Company  
of The Hebrew University of Jerusalem**

---

**Intellectual Property Department**

POB 4279, Jerusalem 91042

Tel: 972-2-563-4880 (ext 204) Fax: 972-2-566-0331

e-mail: [renee@yissum.co.il](mailto:renee@yissum.co.il) or [noemi@yissum.co.il](mailto:noemi@yissum.co.il)

---

13 December 2001

Adv. Meir Dahan  
14 Gruzenberg St.  
5<sup>th</sup> Floor  
Tel Aviv 65811  
**By Registered Mail**

**Re: US Pat Application  
National Phase of PCT/IL99/00057  
*An Automatic Method of Classifying Molecules*  
Our Ref: 2371-02**

Dear Mr. Dahan,

Please find enclosed a copy of the above-referenced application as received from our Patent Attorneys.

We would appreciate it if you could kindly forward a copy to Dr. Golan Yona.

Thank you.

With kind regards,

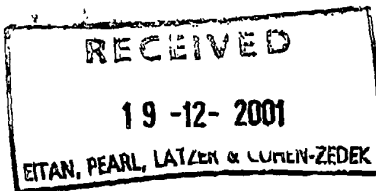
Renée Ben-Israel  
Vice-President  
Intellectual Property

Encl.

הנדסה : 13 : 11/12/01  
מ.ד.ד.

# EXHIBIT 10





**Yissum Research Development Company  
of The Hebrew University of Jerusalem**

**Intellectual Property Department**

POB 4279, Jerusalem 91042

Tel: 972-2-563-4880 (ext 204) Fax: 972-2-566-0331

e-mail: [renee@yissum.co.il](mailto:renee@yissum.co.il) or [noemi@yissum.co.il](mailto:noemi@yissum.co.il)

16 December 2001

Golan Yona, PhD  
Assistant Professor  
Department of Computer Science  
Cornell University  
5156 Upson Hall  
Ithaca, NY 14853-7501  
**By Registered Mail**

**Re: US Pat Application  
National Phase of PCT/IL99/00057  
*An Automatic Method of Classifying Molecules*  
Our Ref: 2371-02**

Dear Golan,

Please find enclosed a copy of the above-referenced application as received from our Patent Attorneys. A copy was forwarded to Adv. Meir Dahan, as well.  
I am also re-sending the Declaration and Power of Attorney and the Assignment forms for your signature.  
We would appreciate it if you could kindly sign and return the documents at your earliest priority.  
Thank you.

With kind regards,

Renée Ben-Israel  
Vice-President  
Intellectual Property

Encl.

# EXHIBIT 11

MEIR DAHAN & CO. - LAW OFFICES

מאיר דהאן ושות' - משרד עורכי דין

14 Greenberg St., 5th Floor, Tel Aviv 65811

רח' גרנברג 14, קומה 5, תל אביב 65811

MEIR DAHAN, LL.M.  
OFER LANKRY, LL.B.  
RON ALUMADSE, LL.B.

טל: 03-5149949  
פקס: 03-5147272  
E-mail: [meir.dahan@meir-dahan.com](mailto:meir.dahan@meir-dahan.com)  
Website: [www.meir-dahan.com](http://www.meir-dahan.com)

מאיר דהאן, עו"ד  
עופר לנקרי, עו"ד  
רון אלמאדס, עו"ד

9 ביטאר, 2002

גם בפקס: 02-5417101 ✓  
מבלי למנוע בזכויות

לכבוד  
מר יהודה גלס, עו"ד  
רח' אוסישקין 26,  
ת.ד. 7722 ירושלים 67134

חגי,

2371

הנדון: ד"ר נולק יונה - יישום חבירה לפיתוח המחקר של תאגיד ביטוח העבירות בישראל

מרשנד שבנדון פנתה שוב אל מרשי, ד"ר נולק יונה, וביקשה ממנו לחתום על ייפוי כוח ומסמכים נוספים בכללם מסמך להעברת זכויות באמצעות.

הנני להודיעכם שוב כי מרשי תוא הבעלים בכל פטנט ובקשה לפטנט בקשר לאמצאה דלעיל בשיעור של 80%, והוא בעל זכויות היוצרים בתוכנת המחשב המשמשת ליישום האמצאה, תכל כפי שפורט בין השאר באכתובת מראשיתם 26.10.2000, 15.6.2001 ו- 1.7.2001.

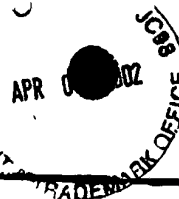
אני מציע שוב שמרשנד תשקול את צעדיה בנדון והעריך נכונה את זכויותי של מרשי.

בכבוד רב ובבי"ח,

מאיר דהאן, עו"ד

הערת: ד"ר נולק יונה

Meir/210/04



**MEIR DAHAN & CO. - LAW OFFICES**  
14 Gruzenberg Street, 5<sup>th</sup> Floor, Tel Aviv 65811

MEIR DAHAN LL.M.  
OFER LANKRILL B.  
RON ALMAGOR LL.B.

Tel: 03 - 5169969  
Fax: 03 - 5167272  
E-mail:  
WEBSITE: [www.dahanlaw.co.il](http://www.dahanlaw.co.il)

January 9, 2002

To:  
Mr. Yehuda Glatt, Adv.  
Ussiskin 24,  
P. O. B. 7722, Jerusalem 67134

[Ticked] Also by fax: 02 - 5617101  
Without prejudice.

Dear Colleague,

Re: Dr. Golan Yona - Yisum Research Development Company of the Hebrew  
University in Jerusalem

Your above client has again approached my client, Dr. Yona Golan and asked him to sign a power of attorney and additional documents including a document for an assignment of his rights to the invention.

We hereby inform you once more that our client is the owner of any patent and of an application for a patent in connection with the above invention at a rate of 80%, and that he is the owner of the copyright for the computer program that is used for the application of the invention, as was specified, inter alia, in our letters dated October 26, 2000, June 18, 2001 and July 1, 2001.

We again propose that your client consider its steps in the above matter and assess my client's rights correctly.

Sincerely and with fraternal greetings,

(-) Signed [Illegible]  
Meir Dahan, Advocate

Copy: Dr. Golan Yona

I certify that this is  
an accurate translation  
of the original  
HEVER TRANSLATORS (INTERNATIONAL) LTD  
34 BEN YEHUDA ST. JERUSALEM

APR

2002

PTO/SB/22 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)

Docket Number (Optional)  
P-1476-US

In re Application of: LINIAL, Michal et al.

Application Number: 09/601,278

Examiner:

Filed: July 31, 2000

Group Art Unit:

For: AN AUTOMATIC METHOD OF CLASSIFYING MOLECULES

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a response in the above identified application.

The requested extension and appropriate non-small-entity fee are as follows (check time period desired):

- |   | <u>Large Entity Fee</u> |            |
|---|-------------------------|------------|
| <input type="checkbox"/> One month (37 CFR 1.17(a)(1))              | \$110                   | \$         |
| <input type="checkbox"/> Two months (37 CFR 1.17(a)(2))             | \$400                   | \$         |
| <input type="checkbox"/> Three months (37 CFR 1.17(a)(3))           | \$920                   | \$         |
| <input checked="" type="checkbox"/> Four months (37 CFR 1.17(a)(4)) | \$1,440                 | \$1,440.00 |
| <input type="checkbox"/> Five months (37 CFR 1.17(a)(5))            | \$1,960                 | \$         |
- ☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the amount shown above is reduced by one-half and the resulting fee is: **\$720.00**
- ☐ A check in the amount of the fee is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 05-0649. I have enclosed a duplicate copy of this sheet.

- I am the ☐ assignee of record of the entire interest.
- ☐ applicant.
- ☒ attorney or agent of record.
- ☐ Attorney or agent under 37 CFR 1.34(a).
- Registration number if acting under 37 CFR 1.34(a).

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

4 April 2002

Date

Signature

Mark S. Cohen, Reg. No. 42,425

Typed or printed name

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representatives(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ Total of forms are submitted.

Burden Hour Statement: This form is estimated to take 0.1 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.